

REMARKS/ARGUMENTS

Claims 1-22 are pending in this Application.

Claims 1, 9, and 17 are currently amended. Applicants submit that support for the claim amendments can be found throughout the specification and the drawings.

Claims 1-22 remain pending in the Application after entry of this Amendment.

No new matter has been entered.

In the Office Action, claims 1-3, 5, 8, 9-11, 13, 16-18, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,796,489 (hereinafter "Slater"), in view of U.S. Patent No. 6,807,633 (hereinafter "Pavlik"). Claims 4, 12, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slater, in view of Pavlik, and in further view of U.S. Patent No. 5,434,917 (hereinafter "Naccache"). Claims 6, 7, 14, 15, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slater, in view of Pavlik, and in further view of U.S. Patent No. 6,584,459 (hereinafter "").

Claim Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections to claims 1-22 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Slater in view of Pavlik, Naccache, and Chang. The Office Action alleges that claimed invention is directed to obvious subject matter, in that the combination of Slater, Pavlik, Naccache, and/or Chang expressly or impliedly disclose or suggest the claimed invention. The Office Action further alleges that one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of Slater, Pavlik, Naccache, and Chang.

Applicants, however, respectfully submit that a prima facie case of obviousness has not been established by the evidence presented in the Office Action. As reiterated by the Supreme Court in KSR International Co. v. Teleflex Inc. (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007), the framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries enunciated by the Court are as follows:

(A) Determining the scope and content of the prior art;

(B) Ascertaining the differences between the claimed invention and the prior art;
and

(C) Resolving the level of ordinary skill in the pertinent art.

To reach a proper determination under 35 U.S.C. § 103(a), the Examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. (M.P.E.P. § 2142).

Applicants respectfully submit that Slater, Pavlik, Naccache, and Chang, either individually or in combination, fail to disclose one or more of the claim limitations recited in each of claims 1-22. These differences, along with other difference, establish that the subject matter as a whole of claims 1-22 would not have been obvious at the time of invention to a person of ordinary skill in the art.

For example, amended claim 1 recites the feature of “in response to the occurrence of the application event, generating the electronic record from data intercepted from the database transaction and displaying the electronic record to the signatory approver according to the defined layout.” However, Slater does not disclose the above limitation. Slater merely discloses that the electronic documents are prepared from data or content entered into a template, although a template may not be required. Thus, if a user seeks to apply for a business, vehicular, or hunting/fishing license in Slater, the user could merely select the corresponding template and fill in the user’s information into the template.

The Office Action alleges that the “signing ceremony” or the coming together of the participants to review and sign the electronic document corresponds to an event as recited in amended claim 1. Applicants respectfully disagree. Coming together to sign for your business license or vehicular license application or to execute the land transaction deal in Slater is substantially different from the events contemplated in the Application. Moreover, the advantages of an electronic signature system is that the parties are not required to come together, as the signor can insert the electronic signature from his/her system (see routing information). In contrast, the event recited in amended claim 1 is an application event. In various embodiments, a

business event setup component 20a allows users to define events 40 that, upon occurrence of the event, trigger an action by another component of system 10, such as an action by ERES engine 22. (Application [0053]). Event 40 is an occurrence in a computer application or program, such as an Internet or intranet application, that is significant to other objects in system 10 or to external agents. (Id.). Therefore, there is a substantial difference between the application event recited in amended claim 1 and the “signing ceremony” or the coming together of the participants to review and sign electronic documents as alleged to be the event in Slater.

Applicants respectfully submit that the above-noted differences between claim 1 and the cited references should be sufficient to overcome the rejection of claim 1 under 35 U.S.C. §103(a). However, Applicants respectfully submits that the cited references also fail to disclose or suggest other claim limitations. For example, amended claim 1 recites the feature of “generating sixth information associating the electronic signature with the electronic record prior to committing the database transaction to a database.”

As discussed in the Application, a method of committing a transaction to a database is provided. (Application: Paragraph [0011]). The method comprises initiating a database transaction and creating an electronic record that includes transaction data from the database transaction. If execution of a rule results in a determination that an electronic signature is required, the electronic signature may be requested prior to committing the transaction to the database. If a valid electronic signature is received, the database transaction can be committed to the database. If a valid electronic signature is not received, the database transaction may be rolled back.

The above recited limitation of amended claim 1 includes a similar feature of requesting an electronic signature prior to committing a database transaction to a database in the context of the Application. For example, as recited in amended claim 1, an electronic signature is requested, and information is generated associating the electronic signature with the electronic record prior to committing the database transaction (from which the electronic record was generated) to the database. Slater fails to disclose this limitation.

The Office Action alleges that Slater discloses the above limitation in that signatures are verified “such that the electronic document is in a suitable state of compliance to

be saved.” However, the Office Action ignores the claim language which recites that the electronic document (one thing) is generated from data intercepted from a database transaction (a second thing). It is the database transaction (the second thing) that is to be committed to the database. The Office Action merely alleges that the electronic document is stored, without considering the database transaction from which the electronic document recited in amended claim 1 is generated. Merely storing the signed electronic document fails to disclose that information associating the electronic signature with the electronic record is generated prior to committing the database transaction to a database as recited in amended claim 1.

Furthermore, with regard to claim 1, the notion that the database transaction can be committed to a database refutes other interpretation by the Examiner. The Examiner has expressed the view in the Office Action that Slater discloses entering data into a template, and that it is inherent that the template of Slate is stored in memory and retrieved as necessary. The Examiner states the retrieval and use of the template in Slater from memory is equivalent to generating the electronic document “from data intercepted from a database transaction” as recited in amended claim 1. The Examiner is respectfully requested to withdraw the rejection because Slater does not disclose that any electronic documents are generated as recited in amended claim 1, i.e., generated upon occurrence of an application event from data intercepted from a database transaction.

Furthermore, the Office Action merely concludes that “the Examiner sees” the retrieval and use of the template in Slater from memory as equivalent to the claimed limitation of intercepting data from a database transaction. However, the Examiner fails to articulate why one of ordinary skill in the art would reach the same conclusion. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” The Federal Circuit’s en banc decision in

Phillips v. AWH Corp., 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard. The USPTO determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Given its plain meaning, the broadest reasonable interpretation “in light of the specification as it would be interpreted by one of ordinary skill in the art” of the term “database transaction” would not be seen as equivalent to the merely retrieval and use of a template from memory as alleged by the Examiner. For example, paragraph [0009] of the Summary states “[a]ccording to one embodiment of the invention, a method of collecting an electronic signature for an electronic record stored in a database is disclosed. The method comprises automatically creating an electronic record from data stored in a plurality of different database tables in response to the occurrence of a predetermined event.” In another example, paragraph [0010] states “a method of associating an electronic signature with an electronic record is disclosed. The method comprises allowing a user to define an event that, upon occurrence, generates an electronic record that requires an electronic signature; allowing a user to define the fields stored in the electronic record; allowing a user to generate a map that maps data from underlying database tables to at least some of the fields defined for the electronic record.” In yet another example, paragraph [0011] states “[i]n another embodiment, a method of committing a transaction to a database is provided. The method comprises initiating a database transaction; creating an electronic record that includes transaction data from the database transaction; executing a rule associated with the record to determine whether an electronic signature is required to connote review and/or approval of the electronic record, and if execution of the rule results in a determination that an electronic signature is required, requesting the electronic signature prior to committing the transaction to the database.”

The Examiner fails to articulate why one of ordinary skill in the art in light of the specification, of which the above examples are part, would also see the alleged retrieval of the template in Slater as intercepting data from a database transaction as recited in claim 1 using the plain meaning of the terms. Further, the Examiner fails to articulate why one of ordinary skill in the art would necessarily recognize the alleged act of retrieval of the template in Slater from the memory to be a database transaction as recited in the claims as understood “in light of the specification as it would be interpreted by one of ordinary skill in the art.”

Applications respectfully submit that Pavlik, Naccache, and Chang, fail to cure the above identified deficiencies of Slater. Thus, Applicants respectfully submit that amended claim 1 is allowable over the cited references.

Applicants respectfully submit that independent claims 9 and 17 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants respectfully submit that dependent claims 2-8, 10-16, and 18-22 that depend directly and/or indirectly from the independent claims 1, 9, and 17 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further respectfully submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

Unless otherwise specified, amendments to the claims are made for the purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof.

While Applicants do not necessarily agree with the prior art rejections set forth in the Office Action, these amendments may be made to expedite issuance of the Application. Applicants reserve the right to pursue claims to subject matter similar to those pending before the present Amendment in co-pending or subsequent applications.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

/Sean F. Parmenter, Reg. No. 53,437/
Sean F. Parmenter
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
SFP:lls
61443264 v1